

Appl. No. 10/806,026  
Response dated November 17, 2006  
Reply to Office Action of May 17, 2006

### **REMARKS**

This is in response to the Office Action dated May 17, 2006. Claims 36-39, 44-47, and 64-74 are pending in the application.

Claims 36-39, 44-47, and 64-74 were rejected.

Claims 36-39, 44-47, and 64-74 were rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art which was relied upon in the rejection adjudicated by the Board in the parent application. Applicants respectfully traverse this rejection.

#### **Res Judicata**

The Examiner alleges that “the current claims are either identical or contain minor variations to the claims adjudicated by the Board in the parent application, and are, therefore, subject to *Res Judicata*. The issues of patentability have been decided by the Board and this renders any diverse action by the examiner impossible.” However, the claims in the current application are not identical to those in the parent application.

Applicants have amended the independent claims to include the limitation “substantially trapezoid shape;” the basis for this amendment can be found in the specification at page 25, lines 14-21 and in Figures 11-14. No new matter has been added by this amendment. The “substantially trapezoid shape” limitation was not present in the claims of the parent application and was not addressed by either the office action or the Board in the appeal of the parent application. Additionally, the Board in the appeal of the parent application citing the Examiner, specifically stated that the limitation of trapezoidal shape was “not present in the claims” addressed therein.

Where there are differences in the claims or when new evidence is presented, application of *res judicata* is not proper. In re Fried, 312 F.2d 930, 136 U.S.P.Q. 429 (CCPA 1963); In re Herr, 377 F.2d 610, 153 U.S.P.Q. 548 (CCPA 1967; MPEP 706.03(w)).

#### **Rejection of Claims 36-39, 44-47, and 64-74 under 35 U.S.C. 103(a)**

Applicants hereby traverse the rejection under 35 U.S.C. §103(a) of claims 36-39, 44-47, and 64-74. In the appeal of the parent case, the claims were rejected based upon combinations of the

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following references: U.S. Patent No. 5,658,519 issued to March, U.S. Patent No. 5,916,932 issued to Nosker, U.S. Patent No. 3,933,731 issued to Machi, U.S. Patent No. 4,165,302 issued to Armenti, U.S. Patent No. 2,985,617 issued to Salyer, U.S. Patent No. 5,128,397 issued to Horsey, U.S. Patent No. 4,925,094 issued to Buckett, and U.S. Patent No. 4,083,491 issued to Hill. In the present application, a general rejection was provided without citation to suggestion or motivation to modify or combine the references, without explanation of the expectation of success, and without showing all of the claimed limitations.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j). Applicants respectfully submit that none of these criteria have been met by the office action dated May 17, 2006.

#### Evidence of Non-obviousness

Applicants submit herewith the Declaration Under 37 C.F.R. 1.132 of John C. Bayer (hereinafter the "Bayer Declaration") which provides evidence of long felt but unsolved need, unexpected and superior results, and commercial success. Applicants hereby incorporate by reference the Bayer Declaration and accompanying exhibits herein. Applicants submit that the Bayer Declaration and accompanying exhibits provide sufficient evidence of nonobviousness to overcome the references cited in the parent application.

The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967). In

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the present application, the problem of replacing chemically treated wood railroad cross ties is well known. Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). In the present application, applicants believe themselves to be the first inventors of the railroad ties as claimed (see Declaration of Inventors previously filed). Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971). MPEP 716.04. The Bayer Declaration provides exhibit attachments which show that the invention as claimed has solved this problem.

“A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue.” *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). The Bayer Declaration shows that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991); MPEP 716.02(a).

To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. MPEP 716.03(b). Again, as indicated by the exhibits to the Bayer Declaration, additional purchases were made specifically due to the performance of the railroad ties as claimed in the present application.

#### Conclusion

Applicants respectfully submit that the application is in condition for allowance. A Notice of Allowance is hereby respectfully requested.

Should the Examiner feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

Applicants respectfully petition the Commissioner for any extension of time necessary to render this paper timely.

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Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,

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Seth M. Nehrbass, Reg. No. 31,281  
e-mail: SethNehrbass@gsnn.us  
Jacqueline M. Daspit, Reg. No. 36,779  
Charles C. Garvey, Jr., Reg. No. 27,889  
Gregory C. Smith, Reg. No. 29,441  
Brett A. North, Reg. No. 42,040  
GARVEY, SMITH, NEHRBASS & NORTH, L.L.C.  
**PTO Customer No. 22920**  
3838 N. Causeway Blvd., Suite 3290  
Metairie, LA 70002  
Tel.: (504) 835-2000  
Fax: 504-835-2070  
www.neworleanspatents.com

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